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DEC 07 2007

**OFFICE OF PETITIONS**

In re Application of :  
Lorin :  
Application No. 09/367,623 : DECISION ON PETITION  
Filed: November 23, 1999 :  
Attorney Docket No. RCA89726 :  
:

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 2, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely and properly reply to the final Office action, mailed February 9, 2004, which set an extendable three month period for reply. On July 30, 2004 (certificate of mailing date July 28, 2004), petitioner filed an amendment after final in response to the February 9, 2004 final Office action and a three month extension of time. This amendment after final failed to place the application in *prima facie* condition for allowance. Therefore, the application became abandoned on August 10, 2004. A Notice of Abandonment was mailed on January 26, 2005.

Petitioner filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment on July 14, 2005 (certificate of mailing date July 12, 2005). The 181 petition was dismissed on September 22, 2005 because the July 30, 2004 (certificate of mailing date July 28, 2004) amendment, while submitted timely due to the purchase of a three month extension of time,

failed to place the application in *prima facie* condition for allowance. This was explained in the Advisory Action Before the Filing of An Appeal Brief mailed with the September 22, 2005 decision on petition.

Petitioner filed a petition under 37 CFR 1.137(b) on October 14, 2005 (certificate of mailing date October 7, 2005) to revive the above-identified application. This petition was dismissed on November 16, 2005. Petitioner was given an extendable two month period from the mail date of the decision to file a reconsideration petition.

The present petition was filed on August 2, 2007, over 1 year and 8 months from the mail date of the November 16, 2005 decision.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See MPEP 711.03(c)(II)(C) and (D).* The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for period (3).

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the delay in filing a grantable petition was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

Where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See MPEP 711.03(c).*

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing petition(s) seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771* ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997)*, which clearly stated that any protracted delay could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See Lawman Armor v. Simon*, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); *Field Hybrids, LLC v. Toyota Motor Corp.*, 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at \*21-\*23. Statements are required from any and all persons then at Thomson Licensing LLC and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the November 16, 2005 decision on petition was mailed, in seeking revival.

Petitioner should include a showing as to how the lengthy delay in filing a reconsideration petition occurred despite the exercise of due care or diligence on the part of the applicant.

Applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also New York University v. Autodesk*, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, \*10 -\*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Petitioner has paid two petition fees. Only one is required. Deposit account no. 07-0832 will be credited \$1,500.00.

Any renewed petition may be addressed as follows:

By Mail:            Mail Stop PETITION  
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By hand:            U. S. Patent and Trademark Office  
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                          401 Dulany Street  
                          Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

  
Shirene Willis Brantley  
Senior Petitions Attorney  
Office of Petitions